

REMARKS

Claims 1-14 and 16-27 are pending in the present application. Claims 5, 9-12, 14 and 25 were amended. Claim 5 and 9-12 were amended to replace the word “highlighted” with the word “selected”. Claims 14 had the phrase “responsive to a user input,” added to the begging of the phrase “sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text.” Claim 25 had the phrase “wherein said sorting step occurs in response to a user input” appended to the phrase “sorting means for sorting the selected text with respect to the selection criteria to form sorted text.” Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness, 1-12, 13, 23, 24 and 26-27

Basis of Rejection

The examiner has rejected claims 1-12, 13, 23, 24 and 26-27 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,714,214 issued to DeMello et al. (herein after *DeMello*) in view of U.S. Patent No. 6,192,396 issued to Kohler (herein after *Kohler*). This rejection is respectfully traversed.

The Office Action states:

With respect to claim 1, DeMello teaches receiving a user input selecting the text from the electronic book to form selected text (a user enables to receive input text from electronic book such as notebook computers, personal digital assistants (PDAs) or handheld devices: col.4 lines 22-25 and col. 5 lines 45-60; also see col. 1, lines 35-40 and col. 2, lines 10-15, and to form a selected text from the input text by highlighting the desired word(s) or text or passage or notation or portion of document: see figs 3A-3B with functions from the pop-up menu such as highlight: col. 6, lines 25-67 and col. 7, lines 20-48).

DeMello teaches data processing under e-book environment from which users enable to create a selected text from an input text or document displayed in the handheld or PDA or notebook or mobile or portable devices and distribute or transmit or transfer the selected text to different users under distributing computer environment. DeMello does not clearly teach automatically sending the selected text to each electronic book for a designated set of recipients in response to the user input selecting the text.

However, Kohler teaches for each recipient, at least one portion of the message is associated with recipient, such that at least one recipient

does not receive all portions of the message (1, lines 60-65, col. 2, lines 30-40; also see abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the teachings of Kohler by incorporating the use of sending portion of message to each recipient in the list recipients such that at least one recipient does not receive all portions of the message. The motivation being to have allowed the use of highlight function to select the text, identifying the recipients from list of recipients and sending the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message. (Office Action dated August 18, 2004, pages 3-4).

The Examiner Bears the Burden of Establishing a *Prima Facie* Case of Obviousness

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention.

The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987).

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Additionally, in comparing *Kohler* to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination.

The Proposed Combination does not Result in the Invention of Claim 1

The present invention in independent claim 1, which is representative of independent claims 13, 23, 24, 26 and 27 with regard to similarly recited subject matter, recites:

1. A method in a data processing system for sharing text in an electronic book, the method comprising:
 - receiving a user input selecting the text from the electronic book to form selected text; and
 - automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.

The examiner concedes and Applicants agree that *DeMello* does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. However, such a feature is not taught or suggested by *Kohler* either. Therefore, the proposed combination does not result in the claimed invention. Accordingly, the examiner has failed to state a prima facie case of obviousness.

The examiner points to the following three passages of *Kohler* as teaching the recited sending feature:

A computerized messaging system which authors messages that contain recipient-specific content, such that each recipient does not necessarily receive a message that is identical to all other recipients. To author a computerized message that contains recipient-specific content, plural portions of the message are authored, and one or more recipients to which at least one portion of the message will be sent are identified. For each recipient, at least one portion of the message is associated with the recipient, such that at least one recipient does not receive all portions of the message. Viewing options are provided to the sender so as to enable the sender to obtain visual cues as to which portions of the message are sent to each recipient or set of recipients, or to allow the sender to view a recipient list for selected portions of the message. At the receiving side, a recipient can view a received message with visual cues such that recipients of private portions of a message can know that others did not receive the private portion, and can further know who received which portions. (*Kohler*, abstract).

For example, recipients for the selected portions of the message may appear colored, underlined or otherwise highlighted when the portions of the message that are received by such recipients has received focus by the sender. The portions of the message itself may also appear colored, underlined or otherwise highlighted, even when not in focus, so as to indicate that the highlighted portion has a limited list of recipients. Color coding or some other form of differential highlighting (such as multiple underlining) may also be employed so as to show which different portions of a message are sent to different sets of recipients. (*Kohler*, col. 2, lines 30-40).

After the author has created the list of recipients, any portion or portions of the message which are to be sent only to certain recipients are selected, such as with a pointing device or with key strokes. (*Kohler*, col. 1, lines 60-65).

The abstract does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. Nowhere does the abstract say that any text is sent automatically, as in the presently claimed invention. Additionally, in the abstract, *Kohler* teaches that his invention applies to a “computerized messaging system.” A computerized messaging system is very different from an electronic book, which is basically a novel in electronic form, which the present invention recites in claim 1. With regard to the abstract, *Kohler* teaches “a computerized messaging system which authors messages that contain recipient-specific content, such that each recipient does not necessarily receive a message that is identical to all other recipients.” *Kohler* further explains that “to author a computerized message that contains recipient-specific content, plural portions of the message are authored, and one or more recipients to which at least one portion of the message will be sent are identified.” Therefore, the abstract does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text in the electronic book.

With regard to the second cited passage, the passage does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. Instead, the second cited passage of *Kohler* teaches using highlighting, underlining or other types of visual indications to show which different portions of text, within one message are to be sent to

which different recipients. In contrast, in the present invention each recipient would receive the same message.

The third cited passage of *Kohler* does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. Instead, the third cited passage of *Kohler* teaches selecting portions of a message that are to be sent only to certain recipients using a pointing device or keystrokes.

None of the passages cited by the examiner teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text, nor is this feature taught anywhere in *Kohler*. Therefore *Kohler* does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. *DeMello* fails to cure this defect. Thus, the proposed combination does not result in the claimed invention. Accordingly, the examiner has failed to state a prima facie case of obviousness.

The Proposed Modification would not be made when the References are considered as a Whole.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). Thus, when *Kohler* and *DeMello* are examined as a whole, *Kohler* teaches one of ordinary skill in the art a process for authoring an e-mail that includes an extra step in which portions of the text are selected and sent only to certain recipients, "such that all recipients do not receive the identical version of the message." (*Kohler*, col. 1, lines 11-12). The passage of *Kohler*, column 1, lines 60-65, cited by the examiner was cited out of context as in merely one step within this process, as can be seen below:

In one aspect, the invention provides for a sender of computerized messages such as E-mail to select portions of the message or attachments which are sent only to certain recipients. In one embodiment, authoring of an E-mail message in which selected portions of the text or attachments are sent only to certain recipients involves the steps of first creating a message and creating a list of recipients. If no contrary instructions are entered, the entire message will be sent to all recipients. After the author has created the list of recipients, any portion or portions of the message which are to be sent only to certain recipients are selected, such as with a pointing device or with key strokes. A list of available recipients is provided to the sender for selection, such as with a "pop-up" menu. The recipients for the selected text are then selected (or selected ones can be deselected, if desired). Any other portions to be sent only to some recipients are also selected in the same way, and the respective lists of recipients for those portions are designated, resulting in a message in which one or more portions are not sent to all recipients. (*Kohler*, col. 1, line 52 – col. 2, line 4).

The above passage of *Kohler* teaches that first the author must create a list of recipients for that particular e-mail. Next, the author must then select portions of the e-mail text to send to only some of the recipients in the list and then choose, from the list of recipients, which recipients will receive the selected text. This process is continued until the author is satisfied with the message, as *Kohler* states in column 7 lines 64 through 67:

After the user has designated the recipients for the various portions of the message, the user can continue adding text and attachments, redesignating recipients, etc., until the user is satisfied.

This is not the same as automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. Additionally, *Kohler* teaches that the message is sent upon the user's manual instruction, not that the selected text is sent automatically, as recited in claim 1 of the present invention:

Once the user is satisfied with the message, the author instructs the message to be sent, and the appropriate portions are sent to the appropriate respective recipients. (*Kohler*, col. 10, line 6-8).

Therefore *Kohler* does not teach the feature of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.

Additionally, when *DeMello* is examined, *DeMello* teaches one of ordinary skill in the art a “technique for allowing a user to interact with the electronic display of documents with a simple user interface.” (*DeMello*, col. 2, lines 53-55). *DeMello* is not concerned with what features the user interface has. Rather, *DeMello* is only concerned about how to generate, a simpler, easier to use user interface. In light of the fact that neither *Kohler* nor *DeMello* show or suggest the claimed feature, one of ordinary skill in the art would not be motivated to make the examiner's proposed modifications to reach the presently claimed invention when *Kohler* and *DeMello* are considered as a whole.

Furthermore, the prior art does not teach the problem or its source. The present invention recognizes sharing highlighted passages and annotation in electronic books. *Kohler* does not teach the problem or its source. *DeMello* does not teach the problem or its source. Instead, *Kohler* is directed towards a process for authoring an e-mail that includes an extra step in which portions of the text are selected and sent only to certain recipients, “such that all recipients do not receive the identical version of the message.” (*Kohler*, col. 1, lines 11-12). *DeMello* is directed towards a “technique for allowing a user to interact with the electronic display of documents with a simple user interface.” (*DeMello*, col. 2, lines 53-55). Therefore, one of ordinary skill in the art would not be motivated to combine or modify the references in the manner required to form the solution disclosed in the claimed invention. Accordingly, the examiner has failed to state a prima facie case of obviousness.

The Office Action has failed to State a Proper Motivation to Combine the References

Additionally, the mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re*

Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

In determining whether a particular combination might be properly combined, whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to **do** rather than obvious to **try**. *In re Clinton*, 527 F.2d 1226, 188 U.S.P.Q. 365 (C.C.P.A. 1976)(emphasis added).

In this case the examiner has not provided a suggestion based on the prior art. The examiner cannot combine references on his own accord. Thus the examiner has failed to provide a motivation to combine the references. Accordingly, the examiner has failed to state a prima facie case of obviousness.

In making an obviousness determination, one cannot pick and choose among the individual elements or assorted prior art references to recreate the claimed invention. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991). Instead, whether the prior art made obvious the invention must be determined by looking for some teaching or suggestion in the references to support their use in the particular claimed invention. *Id*

Moreover, the examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id*. Therefore, absent some teaching, suggestion, or incentive in the prior art, *DeMello* and *Kohler* cannot be properly combined to form the claimed invention. As shown above, the examiner has not shown a proper teaching, suggestion, or incentive from the prior art to make the proposed combination. Thus the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of applicant's disclosure a model for the needed changes. Accordingly, the examiner has failed to state a prima facie case of obviousness.

No Motivation Exists to Combine the References

A proper prima facie case of obviousness must be supported by some teaching or suggestion contained in the combined references. Applicant respectfully submits that the references cited cannot be combined to produce the claimed invention. The rule is:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some **teaching, suggestion or incentive** supporting the combination.

(*In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987))(emphasis added).

DeMello does not give any teaching, suggestion, or incentive to automatically send a selection of text from an electronic book to a designated set of recipients as in the presently claimed invention. *DeMello* teaches a “technique for allowing a user to interact with the electronic display of documents with a simple user interface.” (*DeMello*, col. 2, lines 53-55).

Furthermore, nowhere does *Kohler* teach, suggest, or give any incentive to edit or interact with electronic books or documents. *Kohler* only teaches creating computerized messages “containing recipient specific content such that all recipients do not receive the identical version of the message.” (*Kohler*, abstract; col. 1, lines 9-12). No suggestion of a combination of components necessary to form the present invention can be found in either *DeMello* or *Kohler*. Therefore, one of ordinary skill in the art would not be motivated to combine or modify the references in the manner required to form the solution disclosed in the claimed invention. Accordingly the claims of the present invention are non-obvious in view of *Kohler* in view of *DeMello*.

In view of the above, Applicant submits that independent claims 1, 13, 23, 24, 26 and 27 are not taught or suggested by the alleged combination of *DeMello* and *Kohler*. Claims 2-12 are dependent claims depending on claim 1. At least by virtue of their dependency on an allowable independent claim 1, claims 2-12 are also patentable over *DeMello* and *Kohler*. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-13, 23, 24, 26 and 27 under 35 U.S.C. § 103.

II. 35 U.S.C. § 103, Obviousness, 14, 16-22 and 25

Basis of Rejection

The examiner has rejected claims 14, 16-22 and 25 under 35 U.S.C. § 103 as being unpatentable over *DeMello* in view of U.S. Patent No. 6,192,396 issued to Helfman (hereinafter *Helfman*). This rejection is respectfully traversed.

The Office Action states:

With respect to claim 14, DeMello teaches receiving a user input selecting the text from the electronic book to form selected text (a user enables to receive input text from electronic book such as notebook computers, personal digital assistants (PDAs) or handheld devices: col.4 lines 22-25 and col. 5 lines 45-60; also see col. 1, lines 35-40 and col. 2, lines 10-15, and to form a selected text from the input text by highlighting the desired word(s) or text or passage or notation or portion of document: see figs 3A-3B with functions from the pop-up menu such as highlight: col. 6, lines 25-67 and col. 7, lines 20-48).

DeMello teaches data processing under e-book environment from which users enable to create a selected text from an input text or document displayed in the handheld or PDA or notebook or mobile or portable devices and distribute or transmit or transfer the selected text to different users under distributing computer environment. DeMello does not clearly teach sorting the selected text, displaying the sorted text and responsive to a user input selecting at least a portion of the sorted text being displayed.

However, Helfman teaches automatically sorting the selected into mailboxes based on the criteria defined by user(see abstract, col. 3, lines 1-25) and displaying the sorted the selected message (col. 4, lines 12-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of DeMello with the teachings of Helfman by incorporating the use of sorting the message based on the criteria and displaying the sorted text to user from which the user would be identified which message to be view based on the prioritizing and ranking of the mailbox. The motivation being to have allowed the use of the prioritizing and ranking message from which the message is highlighted/selected via a highlight function, identifying the list from list of recipients sending the portion or portions of message to each recipient who receives only its designated portion or portions of selected text or message. (*Office Action* dated August 18, 2004, pages 9-10).

The Proposed Combination does not Result in the Invention of Claim 14

Amended independent claim 14, which is representative of independent claim 25 with regard to similarly recited subject matter, recites:

14. A method in a data processing system for sharing text in an electronic book, the method comprising:
 - receiving selected text from at least one remote electronic book through a communications link to the data processing system;
 - responsive to a user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text;
 - displaying the sorted text; and
 - responsive to a user input selecting at least a portion of the sorted text being displayed, highlighting portions of the electronic book based on the user input.

The examiner concedes and the Applicant's agree that *DeMello* does not teach sorting the selected text, displaying the sorted text and responsive to a user input selecting at least a portion of the sorted text being displayed. However, such a feature is not taught or suggested by *Helfman* either. Therefore, the proposed combination does not result in the claimed invention. Accordingly, the examiner has failed to state a case of prima facie obviousness.

Helfman does not cure the deficiencies of *DeMello*. *Helfman* does not teach the feature of responsive to a user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text. Instead, *Helfman* teaches automatically sorting incoming electronic mail into mailboxes:

In one form of the invention, a recipient of e-mail messages creates multiple mailboxes, into which incoming mail is automatically sorted, based on criteria established by the user. (*Helfman*, coll. lines 41-44).

Helfman teaches sorting the incoming electronic mail messages at the time they are being fetched from the stored spool and downloaded onto the local computer, as illustrated by the following passage:

The e-mail program 3 in FIG. 1 stores the messages in a "spool" (not shown). When a user fetches e-mail, using a computer 12A in FIG. 1 which is equipped with the Ishmail program, the Ishmail program downloads the user's messages which are spooled in the server 6, via data

link 25.

After downloading, the data packets corresponding to the user's messages become available locally at the user's computer 12A, for the Ishmail program to process. A significant processing feature of the invention allows users to establish, at their local computers 12, multiple different mailboxes, having different names. The Ishmail program sorts the messages into these mailboxes, based on information contained in the various fields of the messages. (*Helpman*, col. 2, lines 50-62).

Further, *Helpman* teaches sorting newly received mail in the same manner, as explained in the following passage:

3. Sorting of current messages. During operation of Ishmail by a user, new messages may arrive in the spool of the e-mail program 3 in FIG. 1. The Ishmail program checks for new messages, downloads them, and then sorts them into the proper mailboxes. (*Helpman*, column 6, lines 43-47).

As can be seen from the above cited passages, the sorting of new messages is done automatically. The present invention, in independent claim 14, recites that responsive to a user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text. Therefore, the sorting of the information, which can be received by means other than electronic mail is sorted by the user, not automatically. Therefore *Helpman* does not teach that responsive to a user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text. Thus *Helpman* does not cure the deficiencies of *DeMello*. Therefore, the proposed combination does not result in the claimed invention. Accordingly, the examiner has failed to state a prima facie case of obviousness.

No Motivation Exists to Combine the References

A proper prima facie case of obviousness must be supported by some teaching or suggestion contained in the combined references. Applicant respectfully submits that the references cited cannot be combined to produce the claimed invention. The rule is:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some **teaching, suggestion or incentive** supporting the combination.

(*In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987))(emphasis added).

Nowhere does *Helpman* teach, suggest, or give any incentive to edit or interact with electronic books or documents. *Helpman* only teaches creating multiple mailboxes for new, incoming message to be sorted into (*Helpman*, col.1, lines 41-44). No suggestion of a combination of components necessary to form the present invention can be found in either *DeMello* or *Helpman* or in the art. Therefore, one of ordinary skill in the art would not be motivated to combine or modify the references in the manner required to form the solution disclosed in the claimed invention. The examiner has not pointed out any teaching, suggestion, or incentive in the prior art to combine the teachings of *DeMello* and *Helpman*. Accordingly, the examiner has failed to state a prima facie case of obviousness.

In view of the above, Applicant submits that amended independent claims 14 and 25 are not taught or suggested by the alleged combination of *DeMello* and *Helpman*. Claims 16-22 are dependent claims depending on claim 14. At least by virtue of their dependency on an allowable independent claim 14, claims 16-22 are also patentable over *DeMello* and *Helpman*. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 14, 16-22 and 25 under 35 U.S.C. § 103.

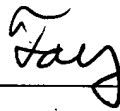
III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: November 16, 2004

Respectfully submitted,



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